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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/662,948

09/16/2003

Shingo Yamauchi

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EXAMINER

MAUST, TIMOTHY LEWIS

ART UNIT

PAPER NUMBER

3751

MAIL DATE

DELIVERY MODE

11/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/662,948	Applicant(s) YAMAUCHI ET AL.	
	Examiner Timothy L. Maust	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-11, 14-16 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-11, 14-16, 20 and 21 is/are allowed.
- 6) ☒ Claim(s) 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/04, 1/04, 9/03</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Reissue Application

The Amendment filed 7/18/08 fails to comply with 37 CFR 1.173(c). Pursuant to 37 CFR 1.173(c), each amendment submitted must set forth the status of all patent claims and all added claims as of the date of the submission. (MPEP 1453 (II)).

The Amendment filed 7/18/2008 fails to comply with 37 CFR 1.173((b) (2)). All amendments in the reissue application must be made relative to (i.e., vis- à-vis) the patent specification in effect as of the date of the filing of the reissue application. The patent specification includes the claims and drawings. All amendments subsequent to the first amendment must also be made relative to the patent specification in effect as of the date of the filing of the reissue application, and **not** relative to the prior amendment (37 CFR 1.173(g)). Therefore, the amended original claim 2 must show brackets for deletions and underlines for addition. The new added claims 14-16 and 20-22 of amendment filed 7/18/2008 need to be underlined. Form paragraph 14.21.01 may be used for this 37 CFR 1.173(b) informality.

Furthermore, there is no compliance with the requirement of 37 CFR 1.173 to point out where there is support for the amendment. Please provide the proper support.

The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

(1) Declaration

The declaration of 9/16/03 is no longer valid because the added new claims 12-13 and 17-19 have been cancelled. The alleged errors and corrections are no longer present in the current reissue declaration filed on 7/18/08.

(2) Supplemental Declaration

The Reissue Declaration filed 7/18/08 failed to properly identify at least one 35 U.S.C.251 error. It is not sufficient for an oath /declaration to merely state "The present reissue is a broadening reissue. Claim 1 of U.S. Patent No. 6,527,018 is broadened by adding new claim 22 (new claim 22 is identical to claim 12 which was added in the preliminary Amendment filed September 16, 2003 and was referred to in the original Reissue Declaration filed on September 16, 2003 and claim 12 was subsequently canceled in the Amendment filed April 26, 2007 since the claim was withdrawn from consideration and no issue regarding the originally filed Reissue Declaration was raised by the Examiner at that time) corresponding to the recitations of claim 11 but omitting the following steps:

" calculating a necessary amount (A) of the material for the following process; and determining a real amount (B) to be prepared in the following batch process by use of a

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maximum amount per one batch process M-max, a minimum amount per one batch process M-min, and a standard amount M-st that is determined between the maximum amount M-max and the minimum amount M-min, the real amount being determined by the following steps:

determining the real amount (B) as the standard amount M-st if the necessary amount (A) is more than twice standard amount M-st;

determining the real amount (B) as a half of the necessary amount (A)/2 if the necessary amount (A) is between twice standard amount and a maximum amount M-max;

determining the real amount (B) as the necessary amount (A) if the necessary amount (A) is between the maximum amount M-max and the minimum amount M-min; and

determining the real amount (B) as the minimum amount M-min if the necessary amount (A) is less than the minimum amount M-min.”

The reissue declaration of 7/18/08 also states that Further, claim 1 of U.S. Patent No. 6,527,018 is broadened by adding new claim 13 (see preliminary Amendment filed September 16, 2003, claim 13 matured into claim 14 by virtue of the Amendment filed on October 29, 2007) corresponding to the recitations of claim 1 but omitting the feature reciting "an allocated amount being equal to or more than a minimum amount one batch process can treat".

The applicant seeks to obtain claims having a scope broader than the scope of the claims in the issued patent. Rather, the oath /declaration must specifically identify an error from the original claims 1-11. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error.

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(MPEP 1414 II. (C)). The errors mentioned and corrected in the reissue oath/declaration of 7/18/08 are no longer there because the applicant canceled the newly added claims 12, 13 and 17-19. The differences between the newly added claims 14-16 and 20-22 and the original cancelled claim 1 and unamended original claims 2-11 must be pointed out (MPEP 1414).

A supplemental oath/declaration under 37 CFR 1.175(b) (1) is needed to cover errors corrected by amendment filed 7/18/08 (add or delete limitations in claims and add or delete claims after filing the Declaration on 9/16/03). Form paragraph 14.05.02 may be used for this matter. To cure this defect, applicant should use Form PTO/SB/51S which maybe downloaded from the USPTO website. See MPEP § 1444 for handling supplemental oaths/declarations.

The reissue claims broaden the scope of the patented claims in at least one respect even though they are narrower in other respects. MPEP 1412.03(I). Therefore, the Supplemental Declaration must be signed by all inventors (not the assignee). MPEP 1414.01 (III). See also *In re Hayes*, 53 USPQ 2d 1222

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: The steps for the “downstream process”.

Final Rejection

Claims 2-11, 14-16, 20 and 21 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Allowable Subject Matter

Claims 2-11, 14-16, 20 and 21 are allowed over the art of record.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy L. Maust whose telephone number is (571) 272-4891. The examiner can normally be reached on Mon. - Thur. 7:00-5:30pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy L Maust/
Primary Examiner
Art Unit 3751

10/24/08